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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,281	08/02/2001	Radislav Alexandrovich Potyrailo	RD-26,350	5671

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GENERAL ELECTRIC COMPANY
GLOBAL RESEARCH
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SCHENECTADY, NY 12301-0008

EXAMINER

SIEFKE, SAMUEL P

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,281

Applicant(s)

POTYRAILO ET AL.

Examiner

Samuel P Siefke

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 37-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-36, drawn to an optical acoustic wave sensor apparatus, classified in class 422, subclass 82.11.
- II. Claims 37-73, drawn to a method of using an optical acoustic wave sensor, classified in class 436, subclass 172.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus can be used to measure the viscoelastic or dielectric properties of a liquid specimen.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Toan P. Vo on 9/23/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **26** recites the limitation "said halogenated hydrocarbons" in claim 26.

There is insufficient antecedent basis for this limitation in the claim. This claim should depend from claim 25 to be proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-24,31-36** are rejected under 35 U.S.C. 102(b) as being anticipated by Ebersole et al. (USPN 5,756,279).

Ebersole discloses an optical acoustic wave sensor for detecting an analyte in a liquid sample. The sensor comprises an optical acoustic wave sensing element (QCM,SH-APM, piezoelectric oscillator SAW, waveguide, col. 6, lines 59-67, col. 9, lines 5-14) having two electrodes coupled to an acoustic wave element (col. 8, lines 48-61); a coating (poly(methyl methacrylate) col. 11, lines 18) being disposed on the acoustic wave element which undergoes a chemical interaction with chemical species to be detected to yield an optically detectable interaction product (col. 9, lines 17-50, col. 14, line 61- col. 15, line 30); a source of electromagnetic radiation optically coupled to

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the acoustic wave sensing element (col. 9, lines 32-50); a first detector for detecting a change (mass, viscoelastic col. 4, lines 27-39; col. 4, lines 59-61) in a property of the optical acoustic wave sensing element (col. 8, lines 48-67); a second detector for detecting an optical property of the interaction product (col. 9, lines 32-50); the QCM is an AT-cut and a BT-cut quartz crystal (col. 7, lines 4-7); the polymeric coating has a thickness between 10 nm and 100 micrometers (col. 4, lines 1-5; col. 9, lines 60-67); the optical waveguide is an optical fiber (col. 3, lines 9-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **25-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebersole et al. (USPN 5,756,279) in view of Friedman.

Ebersole discloses an optical acoustic wave sensor for detecting an analyte in a liquid sample.

Ebersole does not teach detecting chemicals in the group consisting of halogenated hydrocarbons such as TCE trichlorethane and trihalomethanes.

Friedman teaches detecting halogenated hydrocarbons which react with pyridine or alkyl-substituted compounds of pyridine to yield colored products in the presence of a strong base. Colored reaction products of chloroform, bromodichloromethane, chlorodibromomethane, bromoform and TCE strongly absorb at wavelengths of 538-540nm. Therefore it would have been obvious to one having an ordinary skill in the art to modify Ebersole to use a polymeric layer that contains a pyridine or alkyl-substituted compound because of the specific reaction with halogenated hydrocarbons which produce a colored product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the bottom.

February 23, 2004

A handwritten signature in black ink, appearing to be 'Jill Warden' with a stylized flourish.

Jill Warden
Supervisory Patent Examiner
Technology Center 1700